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10/713,736	11/13/2003	Indran Naick	AUS920030776US1(4015)	2704
45557 7590 03/19/2009 IBM CORPORATION (JSS) C/O SCHUBERT OSTERRIEDER & NICKELSON PLLC 6013 CANNON MOUNTAIN DRIVE, S14 AUSTIN, TX 78749				
EXAMINER JEAN GILLES, JUDE				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/713,736

Applicant(s)

NAICK ET AL.

Examiner

JUDE J. JEAN GILLES

Art Unit

2443

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This Office Action is in reply to communication filed on 01/08/2009.

Response to Amendment

1. In this reply, Claims 22-30, 36-40 are amended. There are no newly added or cancelled claims. Claims 22-40 are pending in this application and represent an "OPTIONAL RECEIPT OF AN EMAIL ATTACHMENT".

Response to Arguments

1. Applicant's arguments, see Applicant Arguments/Remarks Made in an Amendment, filed 01/08/2009, with respect to the rejections under 35 U.S.C. § 101 of claims 37-40 in paragraph 2 in page 7 are persuasive. Claims 37-40 are statutory as amended. Accordingly, entry of these amendments are allowed and the § 101 rejections of claims 37-40 have been withdrawn.
2. Applicant's arguments, see Applicant Arguments/Remarks Made in an Amendment, filed 01/08/2009, with respect to the rejections under 35 U.S.C. § 102 (e) of claims 22-40 in paragraph 3 in page 7 have been fully considered and are persuasive. Applicant's main point of contention is that "In response to paragraph 4 of the Office Action, Applicant acknowledges Examiner's rejection of claims 22-40 under 35 U.S.C. § 102 (e) as being anticipated by Marchionda, U.S. Pat. No. 6,628,306 ("Marchionda"). Applicant amends and objects with traverse to Marchionda anticipating Applicant's claims 22-40. Applicant's proposed claim amendments do

not add any new matter, and are supported by the specification.” ...and that does not teach a method in a data processing system ...“wherein the sender selectively enables transmission of the email attachment to the selectable notification recipients through inclusion of the selectable notification with the email ”. While the Examiner sides with the argument above, new patent of Kobayashi teaches this limitation as explained below (see rejection of claim 1 below).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 22-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marchionda, U.S. Patent No. 6,628306, in view of Kobayashi et al (Kobayashi) U.S. Pub. No. 20020010748 A1.

Regarding claim 22, Marchionda discloses:

A method, in a data processing system for selectively transmitting an email attachment of an email (fig. 7, and 8), the method comprising:

selecting, by a sender, email attachment recipients, selectable notification recipients, and excluded recipients for the email to be sent,

wherein the excluded recipients do not receive the email attachment (figs. 7, and 8; column 7, lines 60-67, continue lines 1-12 of column 8);

receiving, from the sender, an instruction to add a selectable notification for the email attachment to the email to be sent to the selectable notification recipients (see abstract; see col. 4, lines 51-62; note the different options built from instructions that is the makeup of the selectable notification),

transmitting the email to the email attachment recipients, the email with the selectable notification to the selectable notification recipients, and the excluded recipients (col. 5, lines 6-27; see abstract, figs 3 and 4; col. 6, 57-67 and col. 7, 1-16). Although Marchionda in substance teaches the invention as claimed, Marchionda appears not to disclose the details of a system "wherein the sender selectively enables transmission of the email attachment to the selectable notification recipients through inclusion of the selectable notification with the email ". This technique is well-known in the art, and it would have been obvious for an ordinary skill in the art to modify the system of Marchionda with this technique as evidenced by Kobayashi.

In the same field of endeavor, Kobayashi discloses an email processing system to selectively transmit and email with attached files as enabled by the user with notification. The user selects attached files that the user wants to attach to the email among a plurality of attached files included

from a list of files; and the selection process includes the user selecting identifiers (code, instruction, mnemonic) sent with the email matching for the attached files. The selectable notification here is the IDs or code included in the email, corresponding the attached files (see par. 0011-0013).

Accordingly, it would have been obvious for an average skill in the art to modify the system of Marchionda, to incorporate the user selectable notification mechanism of Kobayashi ensuring that the email contains simply the selectable notification, not necessarily the actual files which most of the time are deleted when received on mobile terminal or handheld receivers. By this rationale, claim 1 is rejected.

Regarding claims 23-40, the combination Marchionda-Kobayoshi teaches:

23. The method of claim 22, further comprising prompting, the sender, to optionally add comments prior to sending the email attachment to the selectable notification recipients receive the email attachment (Marchionda; col. 8, lines 12-39).

24. The method of claim 22, further comprising prompting, the sender to locate the email attachment for the selectable notification recipients prior to the transmitting the email with the selectable notification to the selectable notification recipients (Marchionda; col. 8, 40-65).

25. The method of claim 22, further comprising transmitting an indication

in the email that the email had the email attachment despite the email attachment being unavailable to the excluded recipients (Marchionda; column 7, lines 60-67, continue lines 1-12 of column 8).

26. The method of claim 22, wherein the receiving an instruction to add a selectable notification comprises inserting code in the form of a markup language for allowing the selectable notification recipients to receive the email attachment (Marchionda; col. 9, lines 7-49).

27. The method of claim 22, wherein the receiving an instruction to add a selectable notification comprises inserting, into the email, an icon linked to code for allowing the selectable notification recipients to receive" the email attachment (Marchionda; col. 1, 11-25, col. 6, 42-56).

28. The method of claim 22, wherein the receiving an instruction to add a selectable notification comprises inserting, into the email, an icon linked to code for allowing the selectable notification recipients to receive the email attachment based on one or more preferences (Marchionda; col. 1, 11-25, col. 6, 42-56).

29. The method of claim 22, wherein the selecting the email attachment recipients comprises selecting recipients the sender chooses to receive the email attachment with the email and without the selectable notification(Marchionda; column

7, lines 60-67, continue lines 1-12 of column 8).

30. A device in a data processing system for selective transmission of an e-mail attachment for an email (Marchionda; figs. 7, and 8), the device comprising:

an email client for composing the email to be sent to email attachment recipients, selectable notification recipients, and excluded recipients, wherein the excluded recipients do not receive the email attachment (Marchionda; column 7, lines 60-67, continue lines 1-12 of column 8; see abstract);

a notification incorporator, in communication with the email client, to add a selectable notification for the email attachment to the email to be sent to the selectable notification recipients (Marchionda; figs. 7-9; see col. 4, lines 51-62; col. 6, 57-67 and col. 7 1-1);

wherein inclusion of the selectable notification with the email selectively enables transmission of the email attachment to the selectable notification recipients (see Kobayashi; par. 0011-0013); and

a code associator, in communication with the notification incorporator, to associate code with the selectable notification for fetching then email attachment in the email to be sent to the selectable notification recipients (Marchionda; see abstract; see col. 4, lines 51-62). The same motivation and reason to combine used for the rejection of claim 1 is also valid for this claim.

31. The device of claim 30, wherein the notification incorporator prompts a sender at the email client to select the email attachment recipients, the selectable notification

recipients, and the excluded recipients (Marchionda; figs 7-9).

31. 32. The device of claim 30, wherein the notification incorporator comprises an icon selector for the selectable notification attachment (Marchionda; col. 1, 11-25, col. 6, 42-56).

33. The device of claim 30, wherein the notification incorporator comprises preferences associated with the email attachment (Marchionda; figs 7-9).

34. The device of claim 30, wherein the code associator comprises code comprising a markup language (Marchionda; col. 9, 8-49).

35. The device of claim 30, wherein the code associator comprises a code generator to generate code, upon activation of the selectable notification, in accordance with one or more preferences associated with the email attachment (Marchionda; col. 9, 8-49).

36. The device of claim 30, further comprising an attachment responder for prompting a sender prior to transmission of the email attachment to the selectable notification recipients, who activated the selectable notification (Marchionda; figs. 7-9).

37. A machine-accessible medium containing instructions, which when executed by a machine, cause the machine to perform operations for selective transmission of an e-mail attachment for an email, comprising: selecting, by a sender, email

attachment recipients, selectable notification recipients, and excluded recipients for the email to be sent, wherein the excluded recipients do not receive the email attachment (Marchionda; figs. 7, and 8; column 7, lines 60-67, continue lines 1-12 of column 8);

receiving, from, the sender, an instruction to add a selectable notification for the email attachment to the email to be sent to the selectable notification recipients (Marchionda; figs. 7-9; see col. 4, lines 51-62; col. 6 57-67 and col. 71-16); wherein the sender selectively enables transmission of the email attachment to the selectable notification recipients through inclusion of the selectable notification with the email

transmitting the email to the email attachment, recipients, the selectable notification recipients., and the excluded recipients (Marchionda; col. 5, lines 6-27; see col. 4, lines 51-62). The same motivation and reason to combine utilized for the rejection of claim 1 is also valid for this claim.

38. The machine-accessible storage medium of claim 37, wherein the operations further comprise instructions for prompting the sender, to optionally add comments and to locate the email attachment prior to sending the email attachment to the selectable notification recipients receive the email attachment (Marchionda; figs 7-9).

39. The machine-accessible medium storage of claim 37, wherein the instructions for receiving an instruction to add a selectable notification comprise inserting, into the email, code in the form of e markup language for allowing the selectable notification recipients to receive the email attachment (Marchionda; col. 9, 8-48).

40. The machine-accessible storage medium of claim 37, wherein the instructions for receiving an instruction to add a selectable notification comprise inserting, into the email, an icon linked to code for allowing the selectable notification recipients to receive the email attachment optionally based on preferences attachment (Marchionda; col. 1, 11-25, col. 6, 42-56).

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from examiner should be directed to Jude Jean-Gilles whose telephone number is (571) 272-

3914. The examiner can normally be reached on Monday-Friday from 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tonia Dollinger, can be reached on (571) 272-4170. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-3301.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-0800.

/Jude J Jean-Gilles/

Primary Examiner, Art Unit 2443

JJG

March 13, 2009